REMARKS

Claims 1-40 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-40 Under 35 U.S.C. §102(b)

Claims 1-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robertson (US 6,609,106). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Robertson does not teach or suggest each and every element of the subject claims.

> A single prior art reference anticipates a patent claim ***only if*** it expressly or inherently describes ***each and every*** limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). (Emphasis added). "A claim is anticipated ***only if each and every*** element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Emphasis added). "The ***identical*** invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added).

The subject invention generally relates to creating an electronic shopping list (*e.g.*, a list of references to items) for a user and utilizing this list to purchase items for the user over the Internet. (*See* Application, p.2, ll.9-11). The systems and methods of the present invention provide a user interface that enables the user to create a personalized list of references to items (*e.g.*, offers, product categories, products from merchants, products from manufacturers...) by electronically selecting and adding such items to their list. (*See* Application, p.2, ll.11-17). This list of references, as well as other users' lists, is stored within an item list database (*See* Application, p.2, ll.17-18) and information related to the referenced items is stored in an item information database(s) (*See* Application, p.6, ll.7-17). In general, an owner of an item list or a customer who intends on purchasing an item for this owner can request the stored list, wherein

an interface component utilizes item references from the stored list to extract related item data from the item information database and employs the extracted data to present a list of items to a requester. (*See* Application, p.7, ll.5-10).

Independent claim 1 (and similarly independent claims 26 and 35) recites an interface component that retrieves ***item references*** from an ***item list database*** in response to a request for items associated with the references and utilizes the references to ***extract*** related ***data*** from an ***information database(s)***, wherein the ***extracted data*** is utilized to ***return a list of requested items*** to the requestor. Robertson does not describe, teach or suggest such claimed aspects. Rather, Robertson is directed to accessing a registrant's pre-stored "Wish" list located at a Gift Registry site. (*See* Abstract).

In particular, Robertson discloses a registrant of the Gift Registry site connects to Service Providers that are also registered with the Gift Registry site and registers items of interest from the Service Providers in a centralized "Wish" list database at the Gift Registry site or a local "Wish" list database, which is transferred to the Gift Registry site and saved within the centralized "Wish" list database. (*See* col.11, ll.25-34; col.12, ll.17-38). Robertson further discloses that a gift purchaser who desires to purchase an item for the registrant locates either the registrant or a registered occasion associated thereto, and the Gift Registry site "displays" the "Wish" list or a filtered "Wish" list to the gift purchaser. (*See* col.15, ll.50-62). If desired, the purchaser can select an item from the displayed "Wish" list in order to display more information about the item. (*See* col.15, ll.59-60). Hence, Robertson discloses a gift registry site that maintains a registrant's "Wish" list, "displays" at least a portion thereof to a purchaser, and facilitates purchasing one or more of the items from the "Wish" list. However, Robertson does not contemplate a component that retrieves item references from one database in response to a user request, utilizes the retrieved references to extract item-related data from a different database(s), and employs the extracted data to create and provide a user with a list of requested items, as recited in the subject claim.

In the subject Final Office Action (dated May 10, 2004), it is contended that Robertson discloses each and every limitation of the subject claim. In particular, the Examiner references column 10, lines 35-55 and column 12, lines 35-40 of Robertson to support a contention that Robertson teaches a "purchaser accesses a wish list database to create an item list based on filtered items in a registrant's wish list which is stored in a database." (*See* Final Office Action,

p.4, ¶1). However, these sections simply note that the "Wish" list is stored in a "centralized" location at the Gift Registry site (*See* col.10, ll.35-55 and col.12, ll.35-40) and that the Gift Registry site can "display" at least a portion of an existing "Wish" list (not create an item list from item references) to the purchaser (*See* col.10, ll.35-55). For example, column 10, lines 38-40 state a user registers his "Wish" list with a "single centralized location" and column 12, lines 38-40 state items can be added to this "Centralized 'Wish' list database." In addition, column 10, lines 35-55 state that a "purchaser has a wide variety of SPs to choose from" and that the "purchaser can filter items in the registrant's 'Wish' list based on ... reseller and cost...." However, this section does not contemplate "creating" a "Wish" list from item references as recited in the subject claim, but rather "displaying" (*See* col.15, ll.57-59) at least a portion of a pre-existing "Wish" list. Thus, neither section discloses item references are stored in one database and associated item information is stored in different database(s), item references are utilized to extract item information, and extracted information is employed to provide the user with an item list, as recited in the subject claim.

In addition, the Examiner references column 23, line 33 - column 24, line 76 of Robertson to support a contention that Robertson teaches "retrieving and utilizing references to items to extract data from a database wherein the data is employed to generate an item list that is returned to the requester." (*See* Final Office Action, p.4, ¶2). The Examiner particularly refers to the discussion of the "Alternate gift button." (*See* Final Office Action, p.4, ¶2). However, column 23, line 33 - column 24, line 67 (it is noted that column 24 ends at line 67, not 76, as stated by the Examiner) does not disclose each and every limitation of subject claim. In particular, the "Alternate Gift Button" is utilized when the purchaser is not satisfied with items registered by the registrant. (*See* col.23, ll.33-35). When invoked, the "Alternate Gift Button" recommends alternate gifts based on "likes and desires of the gift registrant and preferred sellers." (*See* col.23, ll.35-38). However, the discussion of the "Alternate Gift Button" does not mention employing item references from an item list database to extract data from an item information database in order to generate an item list that is returned to a requester, as recited in the subject claim. Moreover, the remaining discussion in this section is related to finding alternate sellers, "checking out" selected items, options available on an SP's product page and locating a registrant *via* a registered occasion.

The Examiner references column 21, lines 59-67 and column 14, lines 50-60 of Robertson to support a contention that Robertson teaches storing item references in an item list database, as recited in the subject claim. (*See* Final Office Action, p.4, ¶3). However, column 21, lines 59-67 of Robertson is directed to a feature that allows a merchant to set filters that restrict which registrants are displayed. In particular, this section identifies criteria, such as "registrants that have registered gifts that match the name identified ... that match the Item UPC ... and/or that match the SP as the Preferred Reseller...," that determines whether to show a registrant. (*See* col.21, ll.59-64). When the merchant is satisfied with their entry, the merchant can save the entry to a Notification database. (*See* col.21, ll.65-67). Column 14, lines 50-60 disclose registering items "directly" to the Gift Registry site in a "Wish" list and utilizing a Maintenance Page to update the "Wish" list. Neither column 21, lines 59-67 nor column 14, lines 50-60 disclose storing item references, to item information in an information database, within an item list database, as recited in the subject claim.

Independent claim 12 (and similarly independent claim 34) recites an interface component that ***degrades*** joined items ***as items are removed*** from an information database(s). In the subject Final Office Action, the Examiner states these claim limitations are interpreted to mean alternative items can be presented to a buyer when a merchant removes an item from an information database. (*See* Final Office Action, pp.4-6). However, Robertson does not teach or suggest degrading items, let alone degrading items as they are removed from an information database, as recited in the subject claim. Robertson discloses a registrant can delete an item from the user's "Wish" list (*See* col. 22, ll. 30-32 and col. 14, ll. 23-52), but Robertson is silent regarding degrading such items as recited in the subject claim. In addition, Robertson discloses a shopper can purchase an item from more than one provider or an item not on the "Wish" list. (*See* col. 23, ll. 27-41). Hence, at most, a buyer has concurrent access to an item *via* more than one service provider or can search for an alternative seller. However, Robertson does not teach or suggest ***degrading*** an item ***in response to the item being removed*** from an information database, as recited in the subject claim.

Independent claim 14 recites at least one ***database with structured and unstructured*** item information that is utilized to return a requested item list to a requestor. In the subject Final Office Action, it is asserted that Robertson discloses such claimed aspects. (*See* Final Office Action, p.6, ¶2). The Examiner references several examples of structured and unstructured data

as provided in the subject application. However, as disclosed in the subject application, such examples are merely examples and do not limit the claimed invention. In addition, Robertson is silent regarding ***storing structured and unstructured item information in an item information database***, as recited in the subject claim. Instead, Robertson merely illustrates that data (*e.g.*, price, manufacturer, URL...), similar to data discussed in connection with various examples in the subject application, can be displayed within a graphical user interface and does not mention how or where the data is stored. (*See* Fig. 41).

Independent claim 20 recites a system that ***links*** an infrastructure of an item list to a remote site such that the ***item list appears to reside on the remote site***. In the subject Final Office Action, the Examiner states "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to arrange the location of the database at any location, since it has been held that rearranging parts of an invention involves only routine skill in the art." (*See* Final Office Action, pp.6-7, ¶3). The Examiner is reminded that the rejection of this claim is an anticipation rejection (under 35 U.S.C. §102(b)) and not an obviousness rejection (*e.g.*, under 35 U.S.C. §103).

With respect to anticipation, the Federal Circuit consistently holds that anticipation is established ***only*** if ***all*** the elements of an invention, ***as arranged in a patent claim***, are identically set forth, in a single prior art reference. (*See Novo Nordisk A/S v. Becton Dickinson and Co.*, 96 F.Supp.2d 309, (S.D.N.Y. 2000) *citing Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). ("[I]t is not sufficient that each element be found somewhere in the reference, the elements ***must be 'arranged as in the claim."***") (Emphasis added); *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) ("'For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference.' These elements must be ***arranged as in the claim*** under review ....") (Emphasis added); *Lindemann* at 1458 ("Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, ***arranged as in the claim***.") (Emphasis added); *Connell v. Sears, Roebuck & Co.* 722 F.2d 1542, 1548 (Fed Cir. 1983) ("Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention ***arranged as in the claim***. A prior art disclosure that 'almost' meets that standard ... does not 'anticipate.'") (Emphasis added). Therefore, pursuant to 35 U.S.C. §102, a reference ***must*** teach ***each and every*** element ***as arranged in the claim*** in order to anticipate.

Assuming *arguendo* an obviousness rejection, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is ***not by itself sufficient*** to support a finding of obviousness. The prior art ***must*** provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." (*Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)) (Emphasis added). Thus, pursuant to 35 U.S.C. §103, Examiner's argument still fails.

Moreover, the Examiner indicates that FIGs 10A and B show "a clear link between the SP site and the gift registry" and that FIG 34 shows "multiple reseller site locations listed linking registered items with remote sites." (*See* Final Office Action, p.6, ¶3). However, "[a] single prior art reference anticipates a patent claim ***only if it*** expressly or inherently ***describes each and every*** limitation set forth in the patent claim." (*Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002)) (Emphasis added). Since Robertson does not describe ***linking*** an infrastructure of an item list to a remote site such that the ***item list appears to reside on the remote site***, Robertson cannot anticipate the subject claim.

Independent claim 24 recites a customization component that adds at least one ***custom item*** to an item list. Robertson does not teach or suggest such claimed aspects. At most, Robertson discloses that a buyer can utilize an "Alternate Gift Button" to select a non-registered gift based on "likes and desires of the gift registrant and preferred resellers." However, Robertson is silent regarding ***adding custom items*** to an item list, as recited in the subject claim.

In view of the foregoing, it is readily apparent that Robertson does not teach or suggest ***each and every element*** in the subject claims. Accordingly, the rejection of independent claims 1, 12, 14, 20, 24, 26, 34 and 35 (and dependent claims 2-11, 13, 15-19, 21-23, 25, 27-33 and 36-40) should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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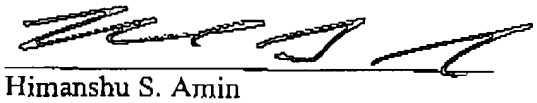

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